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Total Number of Pages in This Submission

4

Application Number	10/730,633
Filing Date	December 8, 2003
First Named Inventor	Philip E. Eggers
Art Unit	3736
Examiner Name	Jeffrey Gerben Hoekstra
Attorney Docket Number	NET 2-100

ENCLOSURES (Check all that apply)

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Firm Name	Mueller and Smith, LPA		
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Printed name	Diane E. Burke		
Date	May 19, 2006	Reg. No.	45,725

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Philip E. Eggers, et al.
Serial No. : 10/730,633
Filed: : December 8, 2003
For: : Electrical Apparatus and System with Improved Tissue
Capture Component
TC/AU : 3736
Examiner : Jeffrey Gerben Hoekstra
Attorney Docket No. : NET 2-100

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RESPONSE TO SPECIES ELECTION

Sir:

This is a response to the April 24, 2006 Office Action containing a species election.

According to the Examiner, the application claims three species that are independent or distinct because they are substantially dissimilar and divergent means for deploying and controlling a tissue volume removal system. In particular, the Examiner has identified Species A identified as "electrical cutting apparatus having 'plural leaf assembly deployable via drive assembly"'; Species B identified as "electrosurgical cutting apparatus having a 'cage assembly deployable via drive assembly including cable stop means"'; and Species C identified as "electrosurgical cutting apparatus having a 'basket assembly deployable via motor drive including cable stop means and drive stop means'". The Examiner finds no claim to be generic.

Applicants initially note that the species-identifying descriptions set apart by quotation marks in the Office action actually are not quotes as the cited language does not appear in the application. (Office Action Page 1, Paragraph 1). Specifically, the application does not use the phrases 1) plural leaf assembly deployable via drive assembly; 2) cage assembly deployable via drive assembly including cable stop means or 3) basket assembly deployable via motor drive including cable stop means and drive stop means. Applicants assume that the quoted language is intended to paraphrase features recited in independent claims 1, 13 and 22. Applicants also would note for purposes of clarity that although the Examiner cites "cable stop means" and "drive stop means", none of the claims of the present application are recited in means plus

function form as defined by 35 U.S.C. § 112, paragraph 6. In fact, the term "means" does not appear anywhere in the application.

Applicants provisionally elect to prosecute Species A. Claims 1-29 read on the elected species because each of these claims includes a "leaf assembly comprising a plurality of elongate thin leafs" and a "drive assembly" as recited in claim 1 and Species A.

Applicants respectfully submit that claim 1 is generic to all three species. The three identified species include a given capture component configuration (e.g., plural leaf, basket or cage) and a particular deployment apparatus (e.g., drive assembly, drive assembly including a cable stop, or motor drive including a cable stop and a drive stop). Claim 1 is generic to all three embodiments because it is broad enough to cover all three capture component configurations and all three drive assemblies. Specifically, claim 1 recites "a tissue capture component... having a leaf assembly comprising a plurality of elongate thin leafs..., said leaf assembly being moveable to deploy outwardly...to define an electrosurgical cutting arc of initially expanding extent and subsequent pursively contracting extent". Claim 1 also recites, "a drive assembly engageable with said leaf assembly base portion and said pursing cable assembly and actuatable to move said leaf assembly to deploy outwardly from said support member while effecting said deployment of said pursing cable assembly."

Species A, B, and C all include a plurality of elongate thin leafs that deploy outwardly and then contract to a given extent. Species B and C are embodiments in which the leafs have been contracted to greater degree to define a basket or cage, as shown in Fig. 6. The terms "basket" and "cage" are used interchangeably in the application. See, for example, page 16, lines 20-22 where profile 268 is referred to as "cage-like." Page 18, lines 17-18 states that, "The locus of travel of the leafs defining a capture in cage is represented somewhat symbolically in phantom at 268." At page 17, lines 24-26, reference is made to "capture basket profile 268". See also page 4, lines 23-28, which states that "Forward movement of the attached cable assembly will be halted and a pursing action will ensue at the electrosurgical cutting leading edge wherein the tip regions of the cables are drawn inwardly with mutually inwardly directed angles of attack until the leaf tip portions converge at a capture position defining a capture basket configuration or tissue recovery cage substantially encapsulating the entire target tissue volume." Claim 1 covers all three embodiments because it requires only that the leaf assembly be capable of being deployed outwardly an initially expanding extent and a subsequent pursively contracting extent.

Claim 1 also is broad enough to read on any of the drive assemblies for deploying and contracting the leaf assemblies of Species A, B, and C. As noted above, claim 1 recites "a drive

assembly engageable with said leaf assembly base portion and said pursing cable assembly and actuatable to move said leaf assembly to deploy outwardly from said support member while effecting said deployment of said pursing cable assembly." Species B simply adds a cable stop to the drive assembly. None of the language of claim 1 specifically excludes a cable stop, therefore, the claim is broad enough to cover Species B. Species C includes a motor drive including a cable stop and drive member stop. Requiring only a "drive assembly", the language of claim 1 is broad enough to include a drive assembly including a motor. Additionally, claim 1 does not exclude either a cable stop or a drive member stop component. As such claim 1 is broad enough to cover the narrower embodiment of Species C which includes these features.

In view of the above, applicants respectfully request that claim 1 be considered generic to Species A, B, and C.

Respectfully submitted,

Date: May 19, 2006

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